UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,793	12/08/1999	Christopher L. Knauft	66703-0002	6923

10291   7590   02/03/2009
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ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
02/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/456,793	KNAUFT ET AL.
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Appeal Brief filed 05/13/2008.

Claims 1-27 are currently pending in this application. Claims 1, 12, 19, and 25

are independent claims.

In view of the Appeal Brief filed 05/13/2008, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection(s) set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(a)   file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

        under 37 CFR 1.113 (if this Office action is final); or,

(b)   request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR

1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below:

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176

Specification

2.   The cross reference related to the application cited in the specification must be
updated (i.e., update the relevant status, with PTO serial numbers or patent
numbers where appropriate). Correction is required.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to
prevent the unjustified or improper timewise extension of the "right to exclude"
granted by a patent and to prevent possible harassment by multiple assignees.
See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); In re
Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re van Ornum, 686 F.2d
937, 214 USPQ 761 (CCPA 1982); In re Uogel, 422 F.2d 438, 164 USPQ 619
(CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R.' 1.321(b) would
overcome an actual or provisional rejection on this ground provided the
conflicting application or patent is shown to be commonly owned with this
application. See 37 C.F.R.' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully

comply with 37 CFR 3.73(b).

Claims 1-27 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-12 of U.S. Patent No.

6,981,217.

Although the conflicting claims are not identical, they are not patentably distinct

from each other because the claims of the instant application and the claims of

patent'217 are claiming common subject matter. The differences between the

claims in the instant application and the claims in patent'217 would have been

obvious to a person of ordinary skill in the art at the time the invention was made,

since the claims in the instant application represent the invention in broader

scope.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 12-15, 19-21, and 25-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Applicant's Admitted Prior Art** (hereinafter, "Admission") in

view of **Kirsch et al.** (US 6070158, filed 11/13/1997).

As to claim 1:

Admission discloses *a computerized method of providing index information for*

secure audiovisual objects to a search engine system (see Specification –

[0007]-[0011] → Admission discloses this limitation in that the prior art includes

information retrieval systems that index "documents" by extracting keywords

and techniques for "retrofitting" information retrieval systems so that the

information retrieval systems can access "documents" protected by digital rights

management software and extract keywords for those "documents"), *the*

method comprising:

- *converting at least a portion of a secure audiovisual object into index*

  information (Admission discloses this limitation in that the prior art includes

  information retrieval systems that index "documents" protected by digital

  rights management software), *wherein the index information is structured for*

use in an index database of a search engine system (Admission discloses

this limitation in that the keywords extracted from the protected "documents"

are "structured for use in an index database of a search engine system"), *and*

wherein the secure audiovisual object is secure in that search engine systems

do not have full access to the secure audiovisual object (Admission discloses

this limitation in that the prior art includes "documents" protected by digital

rights management software); *and*

- *transmitting the index information to the search engine system* (Admission

  discloses this limitation in that the information retrieval systems index the

  keywords extracted from the "secure" "document" in "separate data structures

  optimized for searching"), *wherein the index information is for use in the index*

  database of the search engine system (The examiner notes that this limitation

  was previously recited in the claim and therefore does not further limit the

  claimed invention. The examiner also notes that, in the context of the recited

  "transmitting" step, there is **no novel and unobvious difference** between

  transmitting "***obfuscated***" index information to a search engine and

  transmitting "***unobfuscated***" index information to a search engine. Index

  information, whether it be "obfuscated" or "unobfuscated," is ***simply* data** that

  may be easily transmitted to a search engine. While the particular method

  steps of obfuscating the data may be novel and unobvious, simply

  transmitting "obfuscated" data, versus "unobfuscated" data, is not. As an

aside, the examiner notes that the broad notion of "obfuscating" data is not

novel and unobvious).

Admission fails to expressly disclose:

- *obfuscating at least a portion of the index information so that the intelligibility*
  of the contents of the index information is reduced; and

- *transmitting the* **obfuscated** *index information to the search engine system,*
  wherein the obfuscated index information is for use in the index database of
  the search engine system.

Kirsch teaches

- *obfuscating at least a portion of index information so that the intelligibility of*
  the contents of the index information is reduced (Firstly, the examiner notes
  that "reducing the intelligibility" of data is the **definition** of "obfuscating" in the
  context of the computer programming arts, and the second portion of this
  limitation does not therefore further limit the claimed invention. Secondly, see
  Kirsch - see Figures 3-6; see Column 9, Line 40 through Column 11, Line 7
  → Kirsch teaches this limitation in that the "stop list" terms are filtered and
  removed from the content of the document . Thirdly, as an aside, the
  examiner notes that there are many references in the prior art that may be
  interpreted to cover this claimed feature of the present invention.), for the

purpose of selectively securing the data in the "index information."

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Admission, to include *"obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced,"* for the purpose of selectively securing the data in the "index information," as taught in Kirsch.

As to claim 2:

Kirsch teaches dynamically generating the electronic document comprises at least portion of the obfuscated index information *[See Col. 10, line 18 through Col. 12, line 49; See, also Figs. 3 and 4].*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Admission with Kirsch because it would have allowed for and well supports the parallel search of multiple and distributed document collection indexes, and allowed new documents to be dynamically integrated into the searchable collections through parallel extension of any search to include a real-time updatable document collection index.

As to claim 3:

Kirsch teaches dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document *[See Col. 10, line 18 through Col. 12, line 49; See, also Figs. 3 and 4]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Admission with Kirsch because it would have allowed for and well supports the parallel search of multiple and distributed document collection indexes, and allowed new documents to be dynamically integrated into the searchable collections through parallel extension of any search to include a real-time updatable document collection index.

As to claim 4:

Admission discloses the electronic document comprises a HyperText Markup Language file *(see [0008])*.

As to claims 12-15:

Note the discussions of claims 1-4, respectively, for rejections.

<u>As to claim 19:</u>

The rejection of Claim 1 above is incorporated herein in full.

Additionally, Admission discloses:

- the use of a web server (see [0008]) and

- the web server generating an electronic document based at least in part

    upon the contents of the index information (see [0007]-[0008])

Admission fails to expressly disclose:

- the web server **dynamically** generating an electronic document based at

    least in part upon the contents of the index information.

Kirsch teaches dynamically generating an electronic document based at least in

part upon the contents of the index information *[See Col. 10, line 18 through Col.*

12, line 49; See, also Figs. 3 and 4].

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Admission with Kirsch because it would have

allowed for and well supports the parallel search of multiple and distributed

document collection indexes, and allowed new documents to be dynamically

integrated into the searchable collections through parallel extension of any

search to include a real-time updatable document collection index.

As to claims 20 and 21:

Note the discussions of claims 3 and 4, respectively, for rejections.

As to claim 25:

Refer to the discussion of Claim 19 above for rejection. Claim 25 is the same as claim 19, except claim 25 is a method claim and claim 19 is a system claim.

As to claims 26 and 27:

Note the discussions of claims 3 and 4, respectively, for rejections.

Claims 5 -11, 16-18, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's Admitted Prior Art** (hereinafter, "Admission") in view of **Kirsch et al.** as applied to Claims 1 and 2 above, and further in view of **Nelson et al.** (US **6243713**, filed 08/24/1998).

As to claim 5:

The combination of Admission and Kirsch does not specifically teach the secure audiovisual object comprises a bitmap image.

Nelson teaches the secure audiovisual object comprises a bitmap image *[See Col. 11, lines 34-64; Col.13, line 51-Col.14, line 24; and Figs. 7a-8]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nelson with Admission as modified by Kirsch because it would have indexed compound documents, including multimedia components such as text, images, audio, or video components, into a unified, common index, and then receives and processes compound queries that contain any such multimedia components against the index to retrieve compound documents that satisfy the query.

As to claim 6:

The combination of Admission and Kirsch does not specifically teach the secure audiovisual object comprises music.

Nelson teaches the secure audiovisual object comprises music *[Col. 5, lines 39-67]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nelson with Admission as modified by Kirsch because it would have indexed compound documents, including multimedia components such as text, images, audio, or video components, into a unified,

common index, and then receives and processes compound queries that

contain any such multimedia components against the index to retrieve

compound documents that satisfy the query.

As to claim 7:

The combination of Admission and Kirsch does not specifically teach converting

at least a portion of the secure audiovisual object into index information text

comprises identifying one or more words in the lyrics of the music.

Nelson teaches converting at least a portion of the secure audiovisual object

into index information text comprises identifying one or more words in the lyrics

of the music *[See Col. 2, lines 28- 67; Col. 8, line 1- Col. 9, line 7; and Figs.7a-

8]*.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Nelson with Admission as modified by Kirsch

because it would have indexed compound documents, including multimedia

components such as text, images, audio, or video components, into a unified,

common index, and then receives and processes compound queries that

contain any such multimedia components against the index to retrieve

compound documents that satisfy the query.

As to claim 8:

The combination of Admission and Kirsch does not specifically teach the secure audiovisual object comprises a multimedia presentation.

Nelson teaches the secure audiovisual object comprises a multimedia presentation *[See Col. 2, lines 28- 67; Col. 8, line 1- Col. 9, line 7; and Figs.7a-8]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nelson with Admission as modified by Kirsch because it would have indexed compound documents, including multimedia components such as text, images, audio, or video components, into a unified, common index, and then receives and processes compound queries that contain any such multimedia components against the index to retrieve compound documents that satisfy the query.

As to claims 9 and 11:

The combination of Admission and Kirsch does not specifically teach reading close captioned information that is associated with the audiovisual object.

Nelson teaches reading close captioned information that is associated with the

audiovisual object *[Col. 13, line 51 – Col. 14, line 55].*

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Nelson with Admission as modified by Kirsch

because it would have transformed video data directly into compound

documents, which are then indexed in the multimedia index.

As to claim 10:

The combination of Admission and Kirsch does not specifically teach the secure

audiovisual object comprises streaming media file.

Nelson teaches the secure audiovisual object comprises streaming media file

[Col. 13, lines 51-67 and Fig.7e].

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Nelson with Admission as modified by Kirsch

because it would have transformed video data directly into compound

documents, which are then indexed in the multimedia index.

As to claims 16-18:

Note the discussions of claims 5, 8, and 10, respectively, for rejections.

As to claims 22-24:

Note the discussions of claims 5, 8, and 10, respectively, for rejections.

Response to Arguments

4.   Applicant's arguments with respect to claims 1-27 have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

5.   The prior art made of record, listed on PTO 892 provided to Applicant is

considered to have relevancy to the claimed invention. Applicant should

review each identified reference carefully before responding to this office

action to properly advance the case in light of the prior art.

Contact information

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maikhanh Nguyen/
Examiner, Art Unit 2176

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176